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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,922	04/18/2002	Josep Garces Garces	H 4222 PCT/US	8270
23657	7590	12/16/2004	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			TRAN, SUSAN T	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/018,922	GARCES GARCES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susan T. Tran	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 23-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 23-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/18/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

Receipt is acknowledged of applicant's Preliminary Amendment filed 04/28/02, and Information Disclosure Statement, and Change in Address filed 04/18/02.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is rejected in the use of the phrase "an anionic polymer selected from the group consisting of a salt of alginic acid and an anionic chitosan derivative and active principle" in lines 4-6. The phrase is confusing because it appears to include active principle in the Markush group of an anionic polymer. The use of a "," or a ";" is suggested.

Claim 26 recites the limitation "the heteropolysaccharide" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 26 depends in claim 24, but claim 24 does not recite the limitation "heteropolysaccharide".

Claim 27 recites the limitation "the protein" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 27 depends in claim 24, but claim 24 does not recite the limitation "protein".

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,818,296 ('296). Although the conflicting claims are not identical, they are not patentably distinct from each other because patent '296 claims a microcapsule having a mean diameter of from about 0.1 to about 5 mm, a membrane and a matrix containing at least one active principle wherein the microcapsule is the product of the process comprising the steps of a) forming an aqueous matrix by heating an aqueous solution comprised of a gel former, a chitosan and active principle; (b) forming a dispersed matrix by adding the aqueous matrix in an oil phase; (c) contacting the dispersed matrix with an aqueous solution of an anionic polymer selected from the group consisting of a salt of alginic acid and an anionic chitosan derivative. Patent '296 also claims a process for producing a microcapsule having a mean diameter of from about 0.1 to about 5 mm, a membrane and a matrix containing at least one active principle comprising the steps

of (a) forming an aqueous matrix by heating an aqueous solution comprised of a gel form or, a chitosan and active principle; (b) forming a dispersed matrix by adding the aqueous matrix in an oil phase; (c) contacting the dispersed matrix with an aqueous solution of an anionic polymer selected from the group consisting of a salt of alginic acid and an anionic chitosan derivative. Gel former is protein is found in claim 5. Average molecules weight of the chitosan is found in claims 6 and 7. Active principle is found in claim 8. Amount of active principle is found in claim 9. Temperature carry out in the process is found in claims 11 and 15. It is noted that patent '296 reversed the ingredient in steps (a) and (c) (chitosan and anionic polymer). However, selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). See also *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.). It would have been obvious for one of ordinary skill in the art to, by routine experimentation select any order of adding chitosan and anionic polymer to obtain the claimed microcapsule. Thus, there are no unusual and/or unexpected results, which would rebut *prima facie* obvious.

Claims 23-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,733,790 ('790) in view of Morrison et al. US 5,827,531 ('531). Patent '790 claims a microcapsule having a mean diameter of from about 0.1 to about 5 mm, a membrane and a matrix containing at least one active principle wherein the microcapsule is the

product of the process comprising the steps of (a) forming an aqueous matrix by heating an aqueous solution comprised of a gel former, an anionic polymer selected from the group consisting of a salt of alginic acid and an anionic chitosan derivative and active principle; (b) adding the aqueous matrix to an aqueous solution of chitosan. Patent '790 also claims a process for producing a microcapsule having a mean diameter of from about 0.1 to about 5 mm, a membrane and a matrix containing at least one active principle comprising the steps of (a) forming an aqueous matrix by heating an aqueous solution comprised of a gel former, an anionic polymer selected from the group consisting of a salt of alginic acid and an anionic chitosan derivative and active principle; (b) adding the aqueous matrix to an aqueous solution of chitosan. Patent '790 does not claim the step of adding the aqueous matrix in an oil phase, however, the use of the transitional phrase "comprising" allows additional ingredients and steps. In addition, traditional emulsion method form a O/W/O or W/O/W liquid system in making microcapsule in known in pharmaceutical/cosmetic art. Patent '531 teaches a method for making microcapsule comprising formulating an oil phase containing paraffin, and contacting the formed microcapsule with the oil phase (column 10, lines 25-30). Thus, it would have been obvious for one of ordinary skill in the art to modify the process for producing a microcapsule of patent '790 to contain the step of contacting the formed microcapsule with an oil phase in view of the teachings of patent '531, because patent '531 teaches the oil phase may also be used advantageously to provide the microcapsule with specific characteristics, and because patent '531 teaches the method

that results in more spherical (column 11, lines 59-61), uniform size distributions of microcapsules (column 14, lines 7-35).

***Pertinent Arts***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hayward et al., Rha et al., De Moragas et al., and Bonastre Gilabert et al. are cited as of interest for the teachings of process for making microcapsule.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-0606. The examiner can normally be reached on M-R from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Tran  
Patent Examiner  
AU 1615